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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARCUS L. BELVIN,  
HENRI F. MELI,  
M. SCOTT THOMASON,  
YINGXIN XING,  
and TONG YU

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Appeal 2014-006946  
Application 12/968,871  
Technology Center 3600

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Before HUBERT C. LORIN, ANTON W. FETTING, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.  
FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Marcus L. Belvin, Henri F. Meli, M. Scott Thomason, Yingxin Xing, and Tong Yu (Appellants) seek review under 35 U.S.C. § 134 of a non-final rejection of claims 8–21, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed December 19, 2013) and Reply Brief ("Reply Br.," filed May 28, 2014), and the Examiner's Answer ("Ans.," mailed April 9, 2014), and Non-Final Action ("Non-Final Act.," mailed October 15, 2013).

The Appellants invented a way of creating a dynamic account storing aggregated social data to assist customer knowledge in understanding how an update to a product from one vendor will affect other products or components from others vendors in the complex product environment. Specification para. 1.

An understanding of the invention can be derived from a reading of exemplary claim 8, which is reproduced below (bracketed matter and some paragraphing added).

8. A computer program product embodied in a computer readable storage medium
- for assisting customer knowledge using social media data, the computer program product comprising the programming instructions for:
- [1] delivering a first text-based post regarding an update to a first product of a first company to followers of said first company;
  - [2] receiving a second text-based post from one of said followers of said first company regarding compatibility of said updated first product with one or more other products from one or more other companies;
  - [3] delivering said second text-based post to said followers of said first company;
  - [4] receiving one or more responses to said second text-based post from one or more of said followers of said first company

regarding compatibility of said updated first product with  
said one or more other products from said one or more  
other companies;

[5] aggregating said one or more responses;

and

[6] creating a dynamic account

containing information learned from said aggregated  
responses

regarding compatibility of said updated first product with said one or  
more other products from said one or more other companies.

The Examiner relies upon the following prior art:

Futty et al.	US 2012/0116905 A1	May 10, 2012
Bowen	US 2010/0004980 A1	Jan. 7, 2010

“Taking a tour of Sendible,” [www.sendible.com](http://www.sendible.com), November 9, 2012  
(dating April 2010 – November 2010) last visited January 5, 2017.

Claims 8, 9, 11–13 and 15 stand rejected under 35 U.S.C. § 103(a) as  
unpatentable over Sendible and Futty.<sup>2</sup>

Claims 10, 14 and 16–21 stand rejected under 35 U.S.C. § 103(a) as  
unpatentable over Sendible, Futty, and Bowen.

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<sup>2</sup> A rejection of claims 8, 12, 16, and 19 under 35 U.S.C. § 112, first  
paragraph, as lacking a supporting written description within the original  
disclosure was withdrawn. Ans. 7.

## ISSUES

The issues of obviousness turn primarily on whether Sendible describes text-based posts that include product update information or replies on compatibility of the upgrade with other products.

## FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

### *Facts Related to the Prior Art*

#### *Sendible*

01. Sendible is directed to describing an online social media analytics tool named Sendible. Sendible 1.

#### *Futty*

02. Futty is directed to an application store tastemaker recommendation service that receives a request for information pertaining to an application or a type of application. The service discovers available applications related to the requested application by performing a search, and determines a tastemaker with respect to the available applications and collects data and/or recommendations from the tastemaker.<sup>3</sup> Further, Futty filters and/or ranks the search results based on the collected data, and displays the filtered and/or ranked search results upon receiving an

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<sup>3</sup> Tastemaker - one who sets the standards of what is currently popular or fashionable - <http://www.merriam-webster.com/dictionary/tastemaker>.

indication that a search is complete and/or to repeat the filtering and/or ranking. Fuddy para. 5.

03. Fuddy's tastemaker system has a polling service storing poll questions and their results. The polling service receives answered polls from social acquaintances of a user, tastemakers known throughout the system, and/or social acquaintances of social acquaintances. Additionally, the polling service provides a platform for a user to write poll questions for answering questions about a mobile application being researched, if the user is interested in having a specific question answered. The polling service provides this poll to social acquaintances and tastemakers. Additionally, the poll may be presented to the public and the responses may be weighted based on the tastemaker status of the responders. The polling service provides an answered poll for public access that may be searched by any public search engine. Fuddy para. 27.

04. Fuddy's tastemaker system keeps track of available mobile applications that reside on other systems or, in particular, in other AppStores. In addition, the index differentiates between mobile applications that are compatible with different mobile devices and/or different operating systems. For example, the index stores information about a single document reader that runs on multiple different operating systems. In this way, the tastemaker system filters the application query results based on a type of mobile device and/or operating system. Similarly, the review service and

the polling service may be capable of sorting their reviews and polls in the same way. Fuddy para. 29.

05. Fuddy displays the ranked and/or filtered collection to the user to aid in making a decision. Fuddy determines whether a poll was requested by a user. A user may create a poll designed to ask a question about mobile applications, or other types of applications, in general, about a particular mobile application, about a set of mobile applications, about a type of mobile application, or about any application. Fuddy provides the poll to the user's social acquaintances and tastemakers. Fuddy receives the answered poll and, at block 408, the process 314 may store the poll data. Fuddy paras. 36–37.

*Bowen*

06. Bowen is directed to processing information related to products, and more particularly, to the exchange of information among and between multiple vendors, retailers and consumers over multiple communication technology channels. Bowen para. 2.

## ANALYSIS

We are persuaded by Appellants' argument that "Examiner admits that Sendible does not teach text-based posts that include product update information or replies on compatibility of the upgrade with other products." App. Br. 10. We are further persuaded by Appellants' argument that

[n]either is there any language in the combined teachings of Sendible and Fuddy that teaches delivering the second text-based

post to the followers of the first company. Neither is there any language in the combined teachings of Sendible and Fuddy that teaches receiving one or more responses to the second text-based post from one or more of the followers of the first company regarding compatibility of the undated first product with the one or more other products from the one or more other companies. Neither is there any language in the combined teachings of Sendible and Fuddy that teaches aggregating the one or more responses.

Neither is there any language in the combined teachings of Sendible and Fuddy that teaches creating a dynamic account containing information learned from the aggregated responses regarding compatibility of the undated first product with the one or more other products from the one or more other companies.

*Id.* at 13.

“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed.Cir.2015).

The Supreme Court’s passage does not establish that it suffices for obviousness that a variation of the prior art would predictably work, but requires consideration of whether, in light of factors such as “design incentives and other market forces,” the hypothetical skilled artisan would recognize the potential benefits and pursue the variation.

*Belden Inc.*, 805 F.3d at 1075.

Neither reference describes or suggests a dialog regarding compatibility among products. Fuddy describes cataloging which systems various applications are compatible with for the purpose of recommending applications compatible with a user’s system, but this is not describing compatibility among products. Were this the extent of Examiner’s



omissions in findings, we might be inclined to suggest such a topic might nevertheless be predictable. But more critically, the claims recite a specific implementation for collecting information about this topic by sending information back and forth plural times and then creating an account to aggregate such information in. The Examiner cites a social media management application, Sendible, and describes how it could be used to perform these steps. While we agree that Sendible is eminently capable of doing so, the issue is whether one of ordinary skill would have done so. The Examiner describes why, in hindsight, one might see the advantages of doing so. The Examiner, however, provides no evidence that one of ordinary skill would have thought to perform this specific sequence of steps at the time of the invention.

In responding to Appellants' arguments, the Examiner largely describes why the claims are sufficiently broad to encompass how Sendible could be used as recited in the claims. Ans. 8–15. Again, we agree with this finding. Unfortunately, this finding is not sufficient to show one would have done so. Further, such a back and forth acts as a verification and sanity check on the particular topic of compatibility between different products and so the particular topic recited is functionally related to the steps at least in that sense.

Thus, we find the implementation recited in all independent claims for accumulating information regarding compatibility issues between particular sets of products as neither described nor suggested by the art applied.

## CONCLUSIONS OF LAW

The rejection of claims 8, 9, 11–13 and 15 under 35 U.S.C. § 103(a) as unpatentable over Sendible and Futtty is improper.

The rejection of claims 10, 14 and 16–21 under 35 U.S.C. § 103(a) as unpatentable over Sendible, Futtty, and Bowen is improper.

## NEW GROUND OF REJECTION

The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 8–21 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

### The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First,[] determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question,[] consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an “inventive concept”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

*Alice Corp., Pty. Ltd. v CLS Bank Intl*, 134 S.Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

While the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case's claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The preamble to claim 8 recites that it is a computer product for assisting customer knowledge using social media data. The six steps in claim 8 result in creating a dynamic account containing information. The Specification at para. 1 recites that the invention relates to creating a dynamic account storing aggregated social data to assist customer knowledge. Thus, all this evidence shows that claim 8 is directed to storing information to assist knowledge, i.e. data collection.

It follows from prior Supreme Court cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of data collection is a fundamental business practice long prevalent in our system of commerce. It is literally biblical as recounted in the story of Joseph in Egypt. Thus, data collection, like hedging, is an “abstract idea” beyond the scope of §101. *See Alice Corp. Pty. Ltd.* 134 S.Ct at 2356.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski* and the concept of data collection at issue here. Both are squarely within the realm of “abstract

ideas” as the Court has used that term. *See Alice Corp. Pty. Ltd.* 134 S.Ct at 2357.

The remaining claims merely describe the nature of the data and sending queries for management or subscriptions of such data. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at Mayo step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’ is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

*Alice Corp. Pty. Ltd.*, 134 S.Ct. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S.Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to deliver and receive data, and aggregate the data and storing the data (claims 8–15) or to determine what data represents and create some output that might be characterized as a recommendation (claims 16–21) amounts to electronic data query and retrieval—one of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants' products and systems add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants' claims simply recite the concept of data collection as performed by a generic computer. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of collecting data using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.* 134 S.Ct. at 2360.

As to the structural claims, they

are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.

This Court has long “warn[ed] . . . against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’

*Alice Corp. Pty. Ltd.* 134 S.Ct. at 2360.

The additional phrasing in the claims that appear to be more than generic are really not so. Simply characterizing an account as dynamic is no more than acknowledging the dynamic nature of computer memory. Simply characterizing computer programming stored in memory as circuitry is no more than acknowledging that computer programming stored in memory is physically instantiated as generic computer circuitry. Simply characterizing output as a recommendation is no more than acknowledging that data may be perceived however a user wishes.

## DECISION

The rejection of claims 8–21 is reversed.

The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 8–21 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Our decision is not a final agency action.

This decision contains a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the

following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).  
See 37 C.F.R. § 1.136(a)(1)(iv) (2011).

REVERSED; 41.50(b)